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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,868	03/18/2004	Hiroyuki Iida	Q80457	5449

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EXAMINER

KAYRISH, MATTHEW

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,868

Applicant(s)

IIDA, HIROYUKI

Examiner

Matthew G. Kayrish

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al (US Patent Number 6289640).

Regarding claim 1, Ueda et al disclose:

A sliding member comprising a slidable substrate (figure 2, item 21) and a pressure-sensitive adhesive layer (figure 2, item 3) provided on one side thereof, wherein the slidable substrate is a porous form (column 8, lines 45-51) comprising a plastic (column 8, lines 45-51, polyethylene is plastic), and a barrier layer (figure 2, item 31) is provided between the slidable substrate and the pressure-sensitive adhesive layer (See figure 2).

Regarding claim 2, Ueda et al disclose:

The sliding member as claimed in claim 1, wherein the slidable substrate has a coefficient of friction of 0.2 or lower (column 2, lines 63-65).

Regarding claim 3, Ueda et al disclose:

The sliding member as claimed in claim 1, wherein the slidable substrate is a porous form comprising an ultrahigh molecular weight polyethylene (column 8, lines 38-40).

Regarding claim 5, Ueda et al disclose:

The sliding member as claimed in claim 3, wherein the porous form has a porosity of 20-70% (column 2, lines 54-58).

Regarding claim 6, Ueda et al disclose:

The sliding member as claimed in claim 1, wherein the barrier layer comprises a thermoplastic resin (column 7, lines 56-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al.

Regarding claims 4, 7 and 9, Ueda et al discloses a sliding member including all limitations of the instant claimed invention (see the rejection above) except for:

The ultrahigh molecular weight polyethylene has a molecular weight of 500,000 or higher, as recited in claim 4.

The thermoplastic resin has a melt viscosity of 5-500 kPa•s, as recited in claim 7,
and

The barrier layer has a thickness of 0.01-0.5 mm, as recited in claim 9.

However, it would have been obvious, as a matter of design choice, to one of ordinary skill in the art at the time the invention was made in the course of routine engineering optimization/experimentation to use the ranges used in the disclosed application. Since these ranges are well known in the art.

Moreover, absent a showing of criticality, i.e., unobvious or unexpected results, the relationships set forth in claims 4, 7 and 9 are considered to be within the level of ordinary skill in the art.

It furthermore has been held in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range(s); see *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions; see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

Regarding claim 8, Ueda et al disclose:

The sliding member as claimed in claim 7, wherein the thermoplastic resin is a crosslinked polyethylene (Rubber is a crosslinked polyethylene).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew G. Kayrish whose telephone number is 571-272-4220. The examiner can normally be reached on 8am - 5pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on 571-272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew G. Kayrish

5/24/2006

MK



5/24/2006



THANG V. TRAN
PRIMARY EXAMINER